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IN THE U.S. PATENT AND TRADEMARK OFFICE

EM155714830  
El Rey

Inventor Patrick REINHOLD et al

Patent App. 10/726,817

Filed 2 December 2003

Conf. No. 4112

For CONTINUOUS PROCESS FOR PRODUCTION OF STEEL PART  
WITH REGIONS OF DIFFERENT DUCTILITY

Art Unit 1742

Examiner Roe, J

Hon. Commissioner of Patents  
Box 1450  
Alexandria, VA 22313-1450

Appealed 01-Oct-07

REPLY BRIEF UNDER 37 CFR 41.41

Now come appellants by their duly authorized attorney and submit their reply brief under the provisions of 37 CFR 41.41.

The Examiner's Answer states that "because the apparatus disclosed by Harsch ('716) would have all of the components required by the instant claim, the apparatus disclosed by Harsch ('716) would be capable of performing the same process." Thus it is the examiner's position that functional statements in "means for" clauses in apparatus claims carry no weight. If this is indeed the law, then "means for" expressions are meaningless. In other words the statement in 35 USC 112 that "An element in a claim ... may be expressed as a means .. for performing a specified structure without the recital of structure, material, or acts in

support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

It is respectfully submitted that the examiner has no authority to ignore the statute in formulating a rejection. When a "means for" element in a claim clearly recites a specified function, the examiner must take that function into account. Merely saying that function could perhaps be performed by a known apparatus is not the basis of a rejection. Rule 112 is still in force and should be followed.

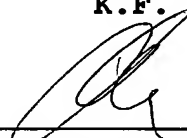
Harsch discloses an oven subdivided in the region in which the workpiece is treated into a succession of zones in each of which a different temperature is maintained. In Harsch the workpiece is fully treated in each of the zones before passing to another zone. Thus this reference does not teach the specified step or function of displacing the workpiece "with a region of the workpiece moving through the one zone and another region of the workpiece moving exclusively through the other of the zones such that the regions are heated to different temperatures." If this language of the claim is not to be ignored, then the instant invention is clearly different from the Harsch system where the entire workpiece is heated to the same temperature in each zone.

It should be noted that Harsch does indeed have lateral air-return channels that are separated from the central workpiece-treating zone by longitudinal partitions. No workpiece is ever moved in these air-circulating channels, and there is in fact no discussion whatsoever of differentially tempering a workpiece in Harsch.

Upholding the examiner's rejection would be tantamount to declaring 35 USC 112 null and void with respect to "means for" expressions in apparatus claims.

Reversal of the rejection is clearly in order.

Respectfully submitted,  
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